

Patent Application No. 10/606,260
Amendment dated March 7, 2006
Reply to Office Action of December 7, 2005

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REMARKS

The Applicants thank the Examiner for the consideration shown the present application thus far. Claims 5-14 are pending and stand rejected. Claims 5 and 12 have been amended to clarify the meaning of the term "reduced". Support for these amendments can be found beginning at page 6 of the present specification.

35 U.S.C. § 112 Rejection

Claims 5-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

The Examiner states that the term "reduced" in Claims 5 and 12 is a relative term and therefore renders the claims indefinite. By the present amendment, the two independent claims are amended to implicitly state that which was implicit in the claims as originally filed. Specifically, the reduction in acrylamide in the snack chips or French fries is relative to the same basic chip or fry that was not treated to reduce the level of acrylamide. In light of the present amendment, Applicants respectfully request reconsideration and allowance of Claims 5-14 over the Examiner's 35 U.S.C. § 112, second paragraph, rejection.

35 U.S.C. § 103 Rejection over Schroeder

Claims 5-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schroeder, et al. (U.S. Patent No. 4,272,554, Herein after "Schroeder"). The Applicants respectfully traverse this rejection.

The Schroeder reference teaches the addition of calcium to a snack chip making process to reduce blistering in the final product. The Examiner asserts that such calcium addition would also reduce the level of acrylamide in the final product. Without addressing the Examiner's assertion (Findings of fact relied upon in making the obviousness rejection must be supported by substantial evidence within the record. See In re Gartside, 203 F.3d 1305, 1315 (Fed. Cir. 2000)), by the present amendment, the claims require that the acrylamide reduction be accomplished by treatment with an enzyme. Schroeder does not teach or suggest the use of enzymes, or the reduction of acrylamide in a snack chip. As such, Schroeder does not teach or suggest the limitations of the present claims. It is respectfully requested that the present rejection of claims 5-9 under 35 USC § 103 over Schroeder be withdrawn.

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35 U.S.C. § 103 Rejection over Elder

Claims 5-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elder, et al. (U.S. Patent Application No. 2004/0058054—hereinafter, Elder). The Applicants respectfully traverse this rejection.

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). If the Examiner does not prove a prima facie case of unpatentability, then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a prima facie case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. And finally, the prior art reference (or references when combined) must teach all of the claim limitations. See, for example, In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the references cited in the Office Action fail to teach all claim limitations, and thus, fail to establish a prima facie case of obviousness under 35 U.S.C. §103.

The Examiner has failed to establish a prima facie case of obviousness because Elder does not teach or suggest an article of commerce that includes a snack chip or a French fry in a container with message that the product within the container contains lower levels of acrylamide than does a comparable untreated chip or fry. The Examiner does not assert that Elder teaches all the limitations of the present claims. Instead, the claim language relating to the container and message is given no patentable weight. The Applicants respectfully disagree that the claim limitations should be given no weight.

Specifically, in *In re Miller*, 164 USPQ 46 (CCPA 1969) and *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), articles comprising previously known compositions, in association with information which was functionally related to such composition, were held novel and non-obvious over the known compositions. For example, in *Miller*, which related to printed information on a measuring device, the Court stated:

[The Examiner's] characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring

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receptacle, volumetric indicia thereon . . . and a legend indicating the ratio, and in our judgment the appealed claims properly define this relationship.

See Miller, at third paragraph from conclusion of opinion.

The Federal Circuit affirmed this holding in *Gulack*, even while recognizing that the “sole difference” between the claimed article and the prior art composition was the printed material. In *Gulack*, the Federal Circuit stated:

A functional relationship of the precise type found by the CCPA in *Miller* – to size or to type of substrate, or conveying information about [the] substrate – is not required. What is required is the existence of differences between the appealed claims and the prior art sufficient to establish patentability.

See Gulack, Section II, B.

Neither *Miller* nor *Gulack* have been overturned by the Court of Appeals for the Federal Circuit. As such, it is believed that the message on the container of the present claims, which tells the consumer that the snack chip or French fry within the container has a reduced level of acrylamide, has a functional relationship to the treated product within the container. Thus, under current CAFC case law, all of the limitations of the present claims should be given patentable weight. And because Elder does not teach or suggest these limitations, the present claims are not obvious over the disclosure of Elder. It is therefore, respectfully requested that the present rejection under 35 USC 103 over Elder be withdrawn.

Double Patenting - Non-Statutory

Claims 5-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of co-pending Application No. 10/606,260. This rejection appears to be in error as the serial number in the office action is the same as the serial number for the present case.

Claims 5-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 13-14 of co-pending Application No. 10/603,978. The '978 application is commonly owned and generally related to the present application. Should the present claims be allowed before those in the '978 application then a Terminal Disclaimer will be filed.

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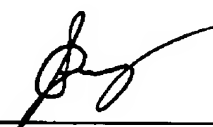
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Conclusion

It is believed that the rejections of the present claims have all been addressed and over come. As such, it is respectfully requested that the rejections under 35 USC §§ 112 and 103 be withdrawn and a prompt notice of allowability be issued.

Respectfully submitted,

DAVID VINCENT ZYZAK, ET AL.



S. Robert Chuey
Registration No. 39,140
(513) 634-0102

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Customer No. 27752